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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALFRED H. JUDGE

Appeal No. 2003-0798
Application No. 09/636,272

HEARD: November 5, 2003

Before THOMAS, RUGGIERO, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 25-31 and 33-37[1]. Claim 32 has been objected to, and claims 33-37 have been indicated as allowable if rewritten in independent form and to overcome the rejection under 35 U.S.C. § 112 (second paragraph).

[1] The amendment (Paper No. 7, filed January 11, 2002) filed subsequent to the final rejection has not been entered by the exminer (Paper No. 8, mailed February 17, 2002).

BACKGROUND

Appellant's invention relates to a level indicator for a power tool. An understanding of the invention can be derived from a reading of exemplary claim 25, which is reproduced as follows:

25. A power tool comprising:

a housing;

a motor within said housing;

an output coupled with said motor;

an activation member for energizing said motor for rotating said output;

a power source electrically coupled with said motor and said activation member; and

a leveling mechanism comprising a light emitting device coupled with said power tool housing and said power source, said light emitting device illuminating to indicate to a user that the power tool is in a horizontal or vertical position.

The prior art references of record[2] relied upon by the examiner in rejecting the appealed claims are:

Jansky	4,141,151	Feb. 27, 1979
Bein et al. (Bein)	4,703,315	Oct. 27, 1987

[2] The examiner (answer, page 3) indicates that a reference to Grant U.S. Patent 5,767,467 has been applied against the claims. However, we find no other mention of this reference in either the answer or the final rejection. Thus, we presume that claims 25-31 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bein in view of Jansky, as set forth in the rejection (answer, pages 4-6).

Claims 33-37 stand rejected under 35 U.S.C. § 112 (second paragraph) as being indefinite. Claims 25-31 stand rejected under 35 U.S.C. § 103(a) as bring unpatentable over Bein in view of Jansky.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 12, mailed July 15, 2002) for the examiner's complete reasoning in support of the rejections, and to appellant's brief (Paper No. 11, filed April 18, 2002) and reply brief (Paper No. 13, filed September 20, 2002) for appellant's arguments thereagainst. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the briefs have not been considered. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of indefiniteness and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into

consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we affirm. We observe at the outset that appellant asserts (brief, page 3) that claims 25-31 stand or fall together. Consistent with this statement, we find that appellant's remarks are directed to independent claim 25[3]. Accordingly, we select claim 25 as representative of the group of claims 25-31.

We begin with the rejection of claims 33-37 under 35 U.S.C. § 112 (second paragraph) as indefinite. The examiner's position (answer, page 4) is that in claim 33, there is no antecedent basis for the phrase "said cavity," and that claim 33 should depend from claim 26. Appellant's position (reply brief, page 1) is that "claim 33 will be amended as suggested by the examiner after the adjudication of the present issues." From our review of claims 33-37, we agree with the examiner that the phrase "said cavity" lacks antecedent basis in claim 25, from which claim 33

[3] We find appellant's reference to claim 1 (brief, page 5) to be misdirected as claim 1 has been canceled; and consider appellant's argument to refer to claim 25.

depends, and that claim 33 should depend from claim 26, which provides antecedent basis for the cavity. Accordingly, the rejection of claims 33-37 under 35 U.S.C. § 112, (second paragraph) is affirmed.

We turn next to the rejection of claims 26-31 under 35 U.S.C. § 103(a) as unpatentable over Bein in view of Jansky. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434,

1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, pages 4) is that Bein indicates whether the level condition is vertical or horizontal, but that it is unclear whether the workpiece referred to is a power tool. To overcome this deficiency in Bein, the examiner turns to Jansky for teaching of a level condition indicator on a power tool, such as a portable drill. The examiner asserts (answer, page 5) that an artisan would have been motivated to use

the leveling device of Bein with the power tool of Jansky in place of Jansky's bubble leveling device because the leveling devices are functionally equivalent and because the LED indicator provides a more visual effect than just a bubble, since it could be recognized more clearly from a remote position.

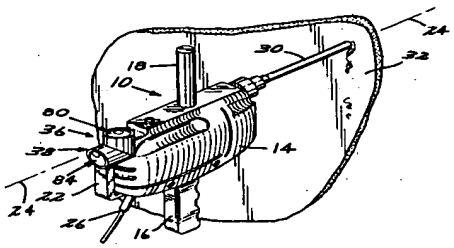
Appellant asserts (brief, page 5) that Bein discloses a staff level that may be placed at a site not accessible to a person, and that the observer of the level must remain at a location remote from the level's location. Appellant further asserts (brief, page 5) that Jansky is directed to an auxiliary level that is added to a position outside of the housing of the drill. Appellant argues (brief, page 6) that Bein and Jansky solve different problems, and that because Bein is interested in providing an audible or visual sensor which is in a level position to notify a remote person of the levelness, that there is no motivation to combine the staff level of Bein with the auxiliary leveling device of Jansky. It is additionally argued (reply brief, page 2) that "[t]he examiner is utilizing hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

Before addressing the examiner's rejection based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 103(a) begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Accordingly, we will initially direct our attention to appellant's claim 25 to derive an understanding of the scope and content thereof.

We find that the claim language "a leveling mechanism comprising a light emitting device coupled with said power tool housing, said light emitting device illuminating to indicate to a user that the power tool is in a horizontal or vertical position" does not specify whether the leveling mechanism is inside the housing (as in appellant's disclosed invention) or coupled to the outside of the power tool housing, as in Jansky. We find that Jansky (col. 1, lines 5-8) is directed to a leveling device for

use in conjunction with a power tool. Jansky recognizes (col. 1, lines 13-18) that the use of a separate leveling device, such as a carpenter's level is "usually extremely cumbersome," and that where both hands are required to use the power tool, the use of a separate level is inconvenient. Jansky's leveling device, as shown in figure 1

(Fig. 1)



includes a plurality of bubble levels 80, 84, where one of the levels indicates deviation from the horizontal and the other level indicates deviation from the vertical (col. 1, lines 21-33). In addition, Jansky discloses that the power drill is in a drill casing 14, and includes handgrip 16, power supply line 26 and drill bit 30. No reference numeral is provided for the motor. From the disclosure of Jansky, we find that Jansky does not disclose the leveling mechanism to include a light emitting device.

Turning to Bein, we find that Bein is directed to a level indicating device, and specifically to a level which emits an audio signal and a visual signal when the desired level condition is attained (col. 1, lines 5-8). Bein discloses (col. 1, lines 9-12) that there are times when a solitary workman needs to adjust a workpiece to a level condition from a site remote from where the level condition is desired. Moreover, Bein discloses (col. 1, lines 15-23) that the "lighting conditions at the workplace are not always ideal for reading a conventional gas bubble type level. In such circumstances, a level indicating device which emits an audible signal or a visual signal upon attaining a level condition enables a workman to make the adjustment without requiring the presence of a second workman at the site where the level indicating device is placed to read when the level condition is attained." In addition, Bein discloses (col. 2, lines 36-38) that the visible signaling means is a light emitting diode LED or an incandescent lamp. In operation (col. 7, lines 17-24), one of the vertical surfaces of housing 11 is placed against a surface which the operator of the device desires

to monitor. For example, the operator can place the device at one end of a plank while raising or lowering the opposite end of the plank. When a level condition has been obtained, buzzer 30 and lamp 32 are activated, and indicate to the operator at a remote location, that the desired level condition has been obtained (col. 7, lines 46-54).

From the disclosure of Bein, we find that Bein's invention is directed to automatically indicating to a remote operator when the level condition has been obtained. This automatic indication by the leveling device of Bein contrasts with the bubble level of Jansky in which the operator looks at the bubble and determines if the level condition has been obtained. From the disclosure of Bein that in some lighting conditions a bubble level is hard to read, we find that an artisan would have been motivated to replace the manually read bubble level of Jansky with the light indicating level of Bein which will automatically notify the operator that a level condition has been attained, without the operator having to make the determination. Although we are cognizant that Bein's level indicator is directed to situations

where the operator is remote from the level, and is more likely to have difficulty in reading the level in low lighting conditions that may be present at a construction site, we find that in view of Bein's disclosure, an artisan would have been motivated to replace the manually read bubble level with a level that automatically provided a read out when the level condition was attained, as an automatic read out on a level would be more convenient to use. From all of the above, we find that the teachings of the prior art as a whole would have fairly suggested to an artisan the replacement of the manually read bubble level of Jansky with the automatically indicating level of Bein. Accordingly, the rejection of claim 25 under 35 U.S.C. § 103(a) is affirmed. Because claims 26-31 fall with claim 25 (brief, page 3), the rejection of claims 26-31 under 35 U.S.C. § 103(a) is affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 25-31 under 35 U.S.C. § 103(a) is affirmed. The decision of the examiner to reject claims 33-37 under 35 U.S.C. § 112 (second paragraph) is affirmed. No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JAMES D. THOMAS)
Administrative Patent Judge)
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JOSEPH F. RUGGIERO) BOARD OF PATENT
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